

## REMARKS

The Office Action mailed September 2, 2010, has been received and reviewed. Claims 1-25 are currently pending in the application. Claim 23 was allowed. Claims 1-22, 24 and 25 stand rejected. Applicant has amended no claims and respectfully requests reconsideration of the application as presented herein. No new matter has been added.

### **35 U.S.C. § 103(a) Obviousness Rejections**

#### Obviousness Rejection Based on U.S. Patent No. 6,112,101 and NPL XP-001017264

Claims 1-4, 6-10, 12, 14-16, 19, 20, 24 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,112,101 to Bhatia *et al.* ("Bhatia") in view of NPL XP-001017264 to Siwko ("Siwko"). Applicant respectfully traverses this rejection, as hereinafter set forth.

The 35 U.S.C. § 103(a) obviousness rejections of claims 1-4, 6-10, 12, 14-16, 19, 20, 24 and 25 are improper because the Office Action is defective and elements for a *prima facie* case of obviousness are not met or are otherwise rebutted.

#### Defective Office Action

**Regarding the defective nature of the Office Action**, the Office Action does not comply with MPEP 707 which requires the Office Action to be complete and the claims properly rejected. 37 C.F.R. §1.104 (b) requires as specifically recited:

**The examiner's action will be complete as to all matters ....** (Emphasis added.)

Applicant respectfully asserts a clear contradiction in the Examiner's arguments. For example, Applicant's independent claim 1 recites, *inter alia*, "**determining** at the mobile station an elapsed time from an effective time of said initial call request block probability." The Office Action states:

***Bhatia fails to disclose determining*** an elapsed time from an effective time of said initial probability. (Office Action, p. 5; emphasis added).

The Office Action then relies upon Siwko for allegedly teaching the missing element.

Specifically, the Office Action states:

*Siwko discloses ... determining* an elapsed time from an effective time of said initial probability .... (Office Action, p. 5; emphasis added).

However, the Office Action then *contradicts* itself. Specifically, the Office Action contradictingly states:

[S]ince *the determination* and comparison *in Bhatia* is done .... (Office Action, pp. 5-6; emphasis added).

Clearly the assertion in the Office Action that “*Bhatia fails* to disclose *determining*” contradicts the Office Action’s later position of “the *determination ... in Bhatia*.” Applicant respectfully asserts that such a contradiction renders the Examiner’s position incomprehensible and, therefore, incomplete as to all matters by foreclosing Applicant from arguing or amending based upon the Office Action’s interpretation and application of the reference.

Accordingly, Applicant respectfully requests the rejections be withdrawn and either the claims allowed or preparation of a complete office action complying with patent rules and MPEP.

### **Siwko Teaches Away**

Regarding the improper application of the Siwko reference to Applicant’s claims, the Office Action fails to apply the specific teachings of Siwko when applying the reference against Applicant’s claims. Specifically in the Response to Arguments, the Office Action states:

3. Regarding applicant’s representative [hereinafter applicant] arguments that Siwko teaches mobile station as not being part of Siwko network; ... *Siwko discloses the probability is determined by a network element but does not specify the element or its location* .... (Office Action, p. 2; emphasis added).

Applicant agrees. However, the Office Action then alleges a *definition* of “network” and asserts a self-serving conclusion that is contradicted by the specific teachings in Siwko.

Specifically, the Office Action alleges:

*[A] network is a series of devices interconnected* by communication channels or combination of elements and devices, *per definition the mobile device is part of the network* and the sections presented by the *applicant talks about the network*,

*system and network resource but do not provide a definitive answer about the mentioned network element.* (Office Action, p. 2; emphasis added).

Applicant agrees that networks are interconnected elements but a conclusion that a “mobile device” is part of the “network” specifically taught by Siwko is not supported by Siwko. Specifically, Siwko unequivocally *teaches away* from a “mobile station” being part of Siwko’s “network.” Generally, Siwko makes a distinction between a “network” and “users” that interface with the network. Clearly a user interfaces with the network using a device such as a “mobile station.”

The Office Action then states:

[S]ince the broadest reasonable interpretation is given to the claims *the examiner cannot exclude possible interpretations unless the reference undoubt[edly] teaches away.* (Office Action, pp. 2-3; emphasis added).

Applicant respectfully asserts that Siwko clearly *teaches away* from the “mobile station” being part of the “network.” In support that Siwko teaches mobile stations as **not** being part of Siwko’s “network”, Siwko specifically discloses:

*Call requests arrive at the system* according to a Poisson point process. (Siwko, p. 1151, col. 1, lns 42-44; emphasis added).

The *network resources* available *to serve* other, lower priority *users* will decrease .... (Siwko, p. 1150, col. 2, lns. 8-9; emphasis added).

*CAC policies protect a network* from overloading *by determining whether incoming call requests* should be accepted or rejected. (Siwko, p. 1150, col. 2, lns. 18-20; emphasis added).

Consider a ... *network serving a class of [] calls* subject to variations in the amount of resources available to serve the class. (Siwko, p. 1151, col. 1, lns 32-35; emphasis added).

Applicant respectfully notes that Siwko uses the term “network” at the beginning of the reference and then interchangeably uses the term “system” for “network” mid-way into the reference. Clearly, Siwko’s teachings above *unquestionably* support **a “network/system” apart from “users” and initiators of “calls” (e.g., “mobile stations”) since the “users” and initiators of “calls” generate “calls” that are “incoming” to the “network/system.”**

Accordingly, Siwko does **not** teach that “mobile stations” are part of the “network.” Therefore, a continued reading of Siwko’s “network” as being inclusive “mobile stations” is improper as

Siwko clearly *teaches away* from such an inclusion.

Applicant's independent claims 1, 8, 14, 19, 24 and 25 each recite, *inter alia*, "**receiving at a mobile station/an apparatus** an initial call request block probability ... and **adjusting at the mobile station/the apparatus** said initial call request block probability **based on** said elapsed time **determined within [the mobile station/the apparatus]**." In contrast, neither Bhatia nor Siwko teach or suggest giving **adjustment control to a mobile station based on something "determined within the mobile station."**

Accordingly, Applicant has rebutted the Office Action's assertions that:

*Siwko discloses that the receiving and adjusting occur at network element [note that network element can be any element connected to the network, including the mobile device], but it is silent regarding at which element is doing those task. However, since the determination and comparison in Bhatia is done at the mobile station. The combination of Siwko will also be done in the mobile station too.* (Office Action, pp. 5-6; emphasis added).

Again, Siwko's "mobile station" is clearly not part of Siwko's "network/system" where any "receiving and adjusting" could occur.

Therefore, Applicant has rebutted any *prima facie* case of obviousness by showing that the art, in any material respect, **teaches away from the claimed invention**. In re Geisler, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). Accordingly, it "is improper to combine references where the references teach away from their combination." M.P.E.P. §2145(X)(D)(2) (citing In re Grasselli, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983)). Accordingly, Applicant respectfully requests the rejection of independent claims 1, 8, 14, 19, 24 and 25 be withdrawn.

The nonobviousness of independent claims 1, 8, 14 and 19 preclude rejection of claims 2-4, 6, 7, 9, 10, 12, 13, 15, 16, 18 and 20 which variously depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claims 1, 8, 14 and 19 and claims 2-4, 6, 7, 9, 10, 12, 13, 15, 16, 18 and 20 which variously depend therefrom.

Obviousness Rejection Based on Bhatia, Siwko and EP 0658014

Claims 7, 13 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bhatia in view of Siwko and further in view of European Patent Applications No. EP 0658014 to Redden *et al.* (“Redden”).

The nonobviousness of independent claims 1, 8 and 14 preclude rejection of claims 7, 13 and 18 which respectively depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claims 1, 8 and 14 and claims 7, 13 and 18 which respectively depend therefrom.

Obviousness Rejection Based on Bhatia, Siwko, Redden and U.S. Patent No. 4,493,102

Claims 5, 11 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bhatia in view of Siwko and Redden and further in view of U.S. Patent No. 4,493,102 to Weishaupt (“Weishaupt”).

The nonobviousness of independent claims 1, 8 and 14 preclude rejection of claims 5, 11 and 17 which respectively depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claims 1, 8 and 14 and claims 5, 11 and 17 which respectively depend therefrom.

Obviousness Rejection Based on Bhatia, Redden and Siwko

Claims 21 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bhatia in view of Redden and further in view of Siwko

To establish a *prima facie* case of obviousness ***the prior art reference (or references when combined) must teach or suggest all the claim limitations.*** *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, there must be “a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742, 167 L.Ed.2d 705,

75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicants' disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

The 35 U.S.C. § 103(a) obviousness rejections of claims 21 and 22 are improper because the elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art references must teach or suggest all the claims limitations. Regarding independent claim 21 and claim 22 depending therefrom, Applicant's independent claim 21 includes claim limitations not taught or suggested in the cited references.

Generally, Applicant's invention recites "determining" and "adjusting" "an initial call request block probability" all occurring at the same entity, namely at the "mobile station." Specifically, Applicant's independent claim 21 recites, *inter alia*, "determining at the mobile station an elapsed time from an effective time of said initial call request block probability, wherein the block probability is determined by a network element and *adjusting at the mobile station* said initial call request block probability *based on said elapsed time determined within the mobile station*, said adjusted call request block probability identifying when the mobile station blocks a call request by foregoing origination of the call request."

The Office Action asserts:

Siwko discloses ... *adjusting* said call request block information (see sections II-IV).  
(Office Action, p. 9; emphasis added).

While Siwko may or may not disclose as alleged, the Office Action has failed to provide any teaching or proper combination alleging "*adjusting at the mobile station* said initial call request block probability" as claimed by Applicant in independent claim 21. The Office Action alleges:

Bhatia discloses ... *receiving at the mobile station* ... and ... *determining at the mobile station* .... (Office Action, p. 8; emphasis added).

However, none of the cited references teach “*adjusting at the mobile station* said initial call request block probability” nor has the Office Action proposed any proper combination of references resulting in *adjusting at the mobile station*. Furthermore, Applicant herein sustains the above proffered arguments relating to Siwko *teaching away* from such capability in Siwko’s “mobile station” as Siwko’s “mobile station” is external to Siwko’s “network” which controls access to the “network.” Accordingly, Siwko would have no need for adjustments in the “mobile station” as claimed by Applicant, and in fact *teaches away* from such sophistication in the mobile stations.

Accordingly, the Office Action is either defective for failing to provide a teaching or proper combination resulting in “*adjusting at the mobile station* said initial call request block probability” as claimed by Applicant in independent claim 21, or any *prima facie* case of obviousness has been rebutted and the rejections must be withdrawn.

The nonobviousness of independent claim 21 precludes rejection of claim 22 which depends therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claim 21 and claim 22 which depends therefrom.

#### **Allowable Subject Matter**

Claim 23 is allowable.

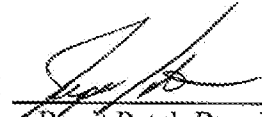
Applicant acknowledges this indication with appreciation.

**CONCLUSION**

Claims 1-25 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicant's undersigned representative.

Dated: 12/2/2010  


Respectfully submitted,

By:   
Rupit Patel, Reg. No. 53,441  
(858) 651-7435

QUALCOMM Incorporated  
5775 Morehouse Drive  
San Diego, California 92121  
Telephone: (858) 658-5787  
Facsimile: (858) 658-2502